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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,398	07/25/2003	Rama Mukherjee	U 014450-3	2850

7590
Ladas & Parry
26 West 61 Street
New York, NY 10023

10/14/2005

EXAMINER

CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,398

Applicant(s)

MUKHERJEE ET AL.

Examiner

Yong S. Chong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 19, 20, 22, 23, 25-27 and 32-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18, 21, 24 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's response filed on 7/29/2005. Applicant's election **with** traverse of the restriction requirement in the reply is acknowledged. The traversal is on the ground(s) that all claims are directed to a single invention. This is not found persuasive because the search for one invention (as grouped in the restriction requirement) will not lead to the search for another invention. The requirement is still deemed proper and is therefore made FINAL. Claims 1-27, 32-43 are pending. Claims 1-16, 18-19, 21-22, 24-25, 27, 32 have been amended. Claims 1-15, 19-20, 22-23, 25-27, 32-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 16-18, 21, 24, 39-43 are examined herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16-18, 21, 24, 39-43 are rejected under 35 U.S.C. 103(a) as being obvious over Liu et al. (Biochem. Cell Biol. Vol. 78, 2000, p. 447-453) in view of Barone et al. (US Patent 5,405,863).

The instant claims are directed to a method of treating cardiac toxicity, myocardial ischemia, myocardial infarction, or heart failure comprising administering 5-methoxytryptamine.

Liu et al. teach that pineal indoles, such as 5-methoxytryptamine (abstract), have antioxidative properties and are a potent scavenger of free radicals (pg. 1, col. 1-2, paragraph 1-2). Male rats were injected with 5-methoxytryptamine at a concentration of 5 mg/kg body weight (abstract) in alcoholic saline (pg. 448, col. 2, paragraph 2). It was found that the activity of superoxide dismutase was enhanced (abstract). Liu et al., however fails to disclose that antioxidants or free radical scavengers can be used to treat cardiac toxicity, myocardial ischemia, myocardial infarction, or heart failure.

Barone et al. teach that antioxidants or oxygen radical scavengers can protect the cardiovascular system including the heart from oxidative damage, particularly myocardial infarction (col. 1, lines 12-23). More specifically, antioxidant enzymes such as superoxide dismutase are taught to treat the significant increase in lipid peroxidation in patients with myocardial infarction (col. 2, lines 33-43).

Examiner would like to point out that biological mechanisms are inherent processes that follow administration of a drug. In the present invention, administration

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of 5-methoxytryptamine inherently results in the increase of activity of superoxide dismutase enzyme, inhibition of lipid peroxidation, reduction of creatine kinase-MB levels, and reduction of lactate dehydrogenase levels, thus are given no patentable weight.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to administer 5-methoxytryptamine to patients suffering from cardiac toxicity, myocardial ischemia, myocardial infarction, or heart failure.

A person of ordinary skill in the art would have been motivated to administer 5-methoxytryptamine to patients suffering from cardiac toxicity, myocardial ischemia, myocardial infarction, or heart failure because of the expectancy to effectively treat the diseases with the antioxidative and free-radical scavenging properties of 5-methoxytryptamine.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC


SHENG JUN WANG
PRIMARY EXAMINER